

REMARKS

The following remarks are offered in response to the Office Action of 12 August 2002.

1. The Examiner indicates claims 3 and 4 are withdrawn from consideration as being drawn to a non-elected group.

In the "Response to Restriction Requirement" filed by applicants on 16 May 2002, the applicants elected to prosecute Group III, claims 1 and 4. Upon review of the Office Action of 8/12/02, the undersigned attorney spoke with Examiner Peterson regarding the discrepancy between the elected claims and those examined. Examiner Peterson indicated that the discrepancy was a product of inadvertent error. It was agreed to prosecute claims 1 and 2 in the present prosecution.

2. Claims 1 and 2 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner indicates that no basis can be found in the specification for the terms "first cooperating mechanical means" and "second cooperating mechanical means". Applicants respectfully disagree.

Applicants direct the Examiner to page 2, lines 19-24 within the *Summary of the Invention* section of the specification wherein it is stated:

The slide and head have first cooperating mechanical means thereon for adjustably limiting the movement of the slide to the plunged blade position, and the slide and the magazine have second cooperating means thereon for adjustably limiting the depth of the magazine insertion in the second channel.

An example of the first cooperating means can be found in the *Detailed Description of the Preferred and Illustrated Embodiments* section of the specification on page 10, lines 26-30. An example of the second cooperating means can be similarly found on page 9, lines 28-37, and page 10, lines 15-22.

Regarding the antecedent basis error identified by the Examiner, applicants have amended the claim to remove the complained of language. Accordingly, applicants request this rejection be withdrawn.

4. Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 3,967,519 issued to Esterly hereinafter referred to as "Esterly") in view of United States Patent No. 4,599,925 issued to Rom (hereinafter referred to as "Rom"). Specifically, the Examiner indicates that "[i]t would have been obvious to one of ordinary skill in the art to have modified Esterly by making the blade magazine slide in a channel with an adjustment mechanism, as suggested by Esterly, in order to better adjust the depth-of-penetration." Applicants respectfully disagree with the Examiner characterization of the references and the rejection based thereon.

When an application is submitted to the Patent and Trademark Office, statute and case law dictates that the burden of proof is on the PTO to establish a prima facie case of obviousness. Once the prima facie case has been established, then the burden of going forward with the evidence to rebut the prima facie case shifts to the applicant. Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO. In this instance, a prima facie case would necessarily have to first establish that the combined teachings of Esterly and Rom render the claimed subject matter obvious, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention. The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art. Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.

Amended claim 1 of the present application claims a head assembly for a cutting machine, that includes:

a head having mounting means for movement of the head assembly on an axis, the head defining a first channel oriented at an oblique angle to the axis; and

a slide mounted for slidable movement in the channel of the head between a withdrawn blade position and a plunged blade position, *the slide having a second channel therein extending substantially parallel to the first channel for receiving a blade-holding magazine inserted therein*, the slide and head having first cooperating mechanical means thereon for adjustably limiting the movement of said slide to said plunged blade position;

wherein the blade-holding magazine is dimensioned and configured for slidable insertion into the second channel in the slide, the slide and magazine

having second cooperating mechanical means thereon for adjustably limiting the depth of magazine insertion into the second channel. (emphasis added)

Esterly discloses a multidirectional web cutter that has a rotatable blade assembly 28 that includes a “blade 32 supported in blade housing 34 by blade clamp 36 and thumb screw 38 as shown in FIGS. 2 and 3” (col.2, lines 27-29). Esterly further discloses a “blade slide 57 *on which is mounted the blade 32...*” (col.2, lines 45-46; emphasis added). Hence, Esterly does not disclose a blade-holding magazine as is claimed in claim 1 (i.e., a blade-holding magazine dimensioned and configured for slidable insertion into a second channel within a slide). Rather, Esterly discloses that a blade 32 is mounted on a slide 57 by a clamp 36 and screw 38. There is no magazine or channel within a slide, and there is consequently no magazine dimensioned and configured for slidable insertion into the channel within the slide.

Rom discloses a fiberboard cutting system that includes a cutter assembly 38. The cutter assembly includes a blade support 56 that is secured to a chuck 52 by a set screw 58. A fastener 64 may be employed for adjustably holding the blade 60 relative to the support 56. The Examiner characterizes the fastener 64 within Rom as a means for adjusting the depth-of-penetration. Applicants find no such disclosure within Rom. On the contrary, Rom discloses that “[f]ine vertical adjustment of the cutting assembly can thus be achieved... by means of drive means” (col.4, lines 28-36). Hence, the Examiner’s characterization cannot be supported.

In sum, from the above it is clearly shown that the combination of the references cited by the Examiner does not disclose the head assembly of claim 1.

In addition, however, applicants respectfully submit that the Examiner’s statement that “[i]t would have been obvious to one of ordinary skill in the art to have modified Esterly by making the blade magazine slide in a channel with an adjustment mechanism, as suggested by Esterly, in order to better adjust the depth-of-penetration” does not provide the requisite suggestion or motivation to combine the cited references to the extent that the Examiner’s statement is understood. It appears that the clause “as suggested by *Esterly*” should read “as suggested by *Rom*”. If applicants’ understanding is incorrect, the examiner is respectfully requested to clarify.

Esterly discloses that the blade 32 is held in place by blade clamp 36 and thumb screw 38. Rom discloses that fastener 64 may be employed for adjustably holding the blade 60. The combination of the two devices would not enable better adjustment of depth-of-penetration as

suggested by The Examiner. On the contrary, Esterly and Rom each disclose specific and considerably different structures for adjusting the depth-of-penetration (Esterly : adjustment screw 42; Rom: drive means). Hence, the suggestion to combine provided by the Examiner (better adjustment) is not suited to the function of the identified blade holding elements. In addition, each reference actually teaches away by specifically disclosing depth adjustment by other means.

In view of the above, applicants respectfully request the rejection of claim 1 be withdrawn and claim1 be passed onto allowance.

5. Claim 2 would be allowable if rewritten to overcome the above 35 U.S.C. §112 rejection and to include all of the limitations of the base claim and any intervening claims.

Applicants thank the Examiner for his provisional allowance of claim 2. Applicants have amended claim 2 to overcome the above 35 U.S.C. §112 rejection and to include all of the limitations of the base claim. Accordingly, applicants respectfully request the Examiner pass claim 2 onto allowance.

As applicants have traversed each rejection and objection raised by the Examiner, it is respectfully requested that the Examiner withdraw the stated rejections and objections, allow claims 1 and 2, and pass the present application on to issuance. If it is determined that a fee is due for the filing of this Amendment, please charge our Deposit Account No. 13-0235.

Respectfully submitted,

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APPENDIX OF MARKED-UP CLAIMS

--1. (Once Amended) A head assembly for a cutting machine, comprising:

a head having mounting means for movement of said head assembly on an axis, said head defining a first channel oriented at an oblique angle to said axis; and

a slide mounted for slidable movement in said channel of said head between a withdrawn blade position and a plunged blade position, said slide having a second channel therein extending substantially parallel to said first channel for receiving a blade-holding magazine inserted therein, said slide and head having first cooperating mechanical means thereon for adjustably limiting the movement of said slide to said plunged blade position; [and]

wherein the [a] blade-holding magazine is dimensioned and configured for slidable insertion into said second channel in said slide, said slide and magazine having second cooperating mechanical means thereon for adjustably limiting the depth of magazine insertion into said second channel.

--2. (Once Amended) A head assembly for a cutting machine, comprising:

a head having mounting means for movement of said head assembly on an axis, said head defining a first channel oriented at an oblique angle to said axis; and

a slide mounted for slidable movement in said channel of said head between a withdrawn blade position and a plunged blade position, said slide having a second channel therein extending substantially parallel to said first channel for receiving a blade-holding magazine inserted therein, said slide and head having first cooperating mechanical means thereon for adjustably limiting the movement of said slide to said plunged blade position;

wherein the blade-holding magazine is dimensioned and configured for slidable insertion into said second channel in said slide, said slide and magazine having second cooperating mechanical means thereon for adjustably limiting the depth of magazine insertion into said second channel; and

[The assembly of Claim 1] wherein said assembly includes a linear motion support system for said slide, said support system comprising, on each of two opposite sides of said slide, an array of at least three elongate rectilinear elements mutually spaced to define a passage therewithin, and a multiplicity of bearing elements loosely stacked in columnar relationship within said defined passage.